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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,035	12/17/1999	MATTI SALLBERG	930049.458C1	9697

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EXAMINER

PARAS JR, PETER

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 05/16/2002

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicant N .

09/466,035

Applicant(s)

SALLBERG ET AL.

Examiner

Peter Paras, Jr.

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 April 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 22 April 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-5, 12, 13, 24 and 25.

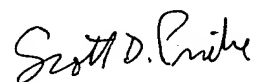
Claim(s) withdrawn from consideration: 6-11.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE: The proposed claims are now directed to methods of generating an immune response against intracellular pathogens. However, such an amendment broadens the scope of the claim to the extent that a new search and possibly new rejections under 102 and/or 103 would be required. Furthermore, amending the claims to recite such also would create a new matter issue because an immune response is described in the instant specification only in terms of therapeutic benefit. The broader scope of an immune response, now recited in the claims, for example as it relates simply to generating antibodies in an animal, is not literally or figuratively supported by the instant specification.

Continuation of 5. does NOT place the application in condition for allowance because: the rejection under 112, 1st paragraph is maintained. Applicants have argued that the instant claims do not recite methods of treating but instead are directed to methods of generating an immune response to intracellular pathogens. See pages 4-5 of the amendment after final. In response, the Examiner asserts that such arguments are directed to the proposed claims filed on April 22, 2002. Since the proposed claims have not been entered, such arguments are moot. Applicants have argued that the instant claims cannot be rejected because one implied use may be ineffective or inoperative. See page 5 of the amendment after final. In response, the Examiner reminds Applicants that only the proposed claims appear to be directed to other uses of the claimed invention. The claims as originally filed were directed to methods of treating. As such no implied uses were read into the claims and Applicant's arguments with regard to other uses of the claimed invention are moot. Applicants argue that the references cited by the Examiner, Frolov, Ohno, and Garoff are not directed to generating an immune response to an intracellular pathogen. See page 5-6 of the amendment after final. In response, the Examiner asserts that such arguments are moot as only the proposed claims are directed to generating an immune response. Frolov, Ohno, and Garoff were cited to support the unpredictability of alphaviruses in the art of gene therapy with regard to host response, targeting of specific cell types, and cytopathogenicity. The evidence of record does not suggest otherwise. See pages 2-3 of the Office action mailed on 10/10/01. Finally, Applicants have argued that the instant specification has provided more than sufficient guidance for practicing the claimed methods. In response, the Examiner asserts that the originally filed claims were directed to methods of treatment, which fell into the art of gene therapy. Gene therapy as of Applicant's effective filing date was unpredictable and has remained so thereafter. See Verma and Marshall on pages 2-3 of the Office action mailed on 10/10/01. Any arguments directed to the proposed claims are moot as such have not been entered.

Continuation of 10. Other: The amendment does not comply with 37 C.F.R. 1.121 because the marked up and clean versions of the claims do not match with respect claims 5 and 25. See 37 CFR 1.111. It would be less confusing and helpful to the Examiner if only the presently amended claims were listed in the marked up version of the claims.



SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER